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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,426	12/27/2001	Peter Vischer	1803-325-999	9281

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,426

Applicant(s)

VISCHER ET AL.

Examiner

Jeffrey Fredman

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 3, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 2-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon et al (U.S. Patent 6,309,875).

Gordon teaches a system for processing a nucleic acid sample contained in a liquid (see figures 1-4, for example), comprising:

(a) a cartridge for processing a liquid nucleic acid sample (see figure 3 and column 7), including;

(a.1) a chip shaped carrier having an active surface which carries an array of oligonucleotide, said active surface facing an inner surface of a wall of said cartridge (see figure 3 and column 7, lines 10-22 and column 8, lines 20-27),

(a.2) a chamber having a narrow interior and including a channel that lies between the inner surface and the active surface (see figure 3 and column 7, lines 10-22, where there are channels and a reaction chamber between a cover and the oligonucleotide array),

(a.3) a rigid segment that is adapted to being centrifuged (see figures 2 and 3 and column 6, for example, where the carrier is placed in a centrifuge for centrifugation),

(b) a cartridge holder that is adapted to hold said cartridge in the vertical plane (see figure 1 and column 6, line 20, which expressly discusses vertical mixing),

(c) means for swinging said rigid segment back and forth (see figures 1-4 and column 5, lines 14-55, where the swinging is centrifugation).

With regard to claim 3, Gordon teaches placement of the carrier in a "substantially" vertical plane (see figure 1 and column 6, line 20).

With regard to claim 4, Gordon teaches the cartridge as described above.

3. Claims 2-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (U.S. Patent 5,858,671).

Jones teaches a system for processing a nucleic acid sample contained in a liquid (see figures 8-9, for example), comprising:

(a) a cartridge for processing a liquid nucleic acid sample (see figure 9 and column 36, line 59 to column 37, line 59), including;

(a.1) a chip shaped carrier (see column 36, line 65, for example) having an active surface which carries an array of oligonucleotides (see column 36, line 9 and column 37, lines 5-20), said active surface facing an inner surface of a wall of said cartridge (see figure 9),

(a.2) a chamber having a narrow interior and including a channel that lies between the inner surface and the active surface (see figure 9, where there are channels and a reaction chamber between a cover and the oligonucleotide array),

(a.3) a rigid segment that is adapted to being centrifuged (see figures 9 and column 37, for example, where the carrier is placed in a centrifuge for centrifugation),

(b) a cartridge holder that is adapted to hold said cartridge in a "substantially" vertical plane (see figure 9 and column 36, lines 59-67),

(c) means for swinging said rigid segment back and forth (see figures 8-9 and column 37, where the swinging is centrifugation).

With regard to claim 3, Jones teaches placement of the carrier in a "substantially" vertical plane (see figure 8-9).

With regard to claim 4, Jones teaches the cartridge as described above.

It is noted that the claim phrase "substantially vertical plane" is extremely broadly interpreted for purposes of this rejection. Further, the term "vertical" itself must be related to some other component. Here, the arrays are vertical relative to the centrifugation drive, since they are in a different plane than the drive as shown in figure 9.

Response to Arguments

4. Applicant's arguments filed March 3, 2004 have been fully considered but they are not persuasive.

Applicant entire argument with regard to both references is drawn to the intended use of the cartridge, and not to a structural distinction of the cartridge itself. That is, Applicant argues that there is movement of the rigid segment within the cartridge and not movement of the entire cartridge. This is not a structural limitation of the claim but rather a method of using the product of the claim. Since the claims are not method claims, intended use recitations do not carry any patentable weight. As MPEP 2111.02 notes "Intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." It is clear that a structural difference must exist between the claimed invention and the prior art to overcome the rejection and not simply a difference in the intended use. As MPEP 2111.02 also notes "a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone."

Here, there are no structural differences between the claims and the prior art products of Gordon or Jones. While Applicant may intend to use the cartridge in a different way, this does not represent a patentable distinction over the cited prior art.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey Fredman
Primary Examiner
Art Unit 1637